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FITZPATRICK CELLA HARPER & SCINTO 30 ROCKEFELLER PLAZA NEW YORK, NY 10112			ENGLAND, DAVID E	
			ART UNIT	PAPER NUMBER
			2143	

DATE MAILED: 11/03/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/588,683	USHIDA, KATSUTOSHI	
	Examiner	Art Unit	
	David E. England	2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 29 July 2005.

2a) This action is FINAL. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-52 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-52 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All b) Some * c) None of:

1. Certified copies of the priority documents have been received.

2. Certified copies of the priority documents have been received in Application No. _____.

3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 06/29/2005. *PL*

4) Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.

5) Notice of Informal Patent Application (PTO-152)

6) Other: _____.

DETAILED ACTION

1. Claims 1 – 52 are presented for examination.

Claim Objections

2. Claim 2 is objected to because of the following informalities: The newly added limitation of “after the formal of the image data” appears to be a misspelling and should be “the format”. Appropriate correction is required.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claims 1, 2, 4, 7 – 15, 25, 27, 30, 31, 34 – 38, 42, 43, 45, 47, 49, 51 and 52 are rejected under 35 U.S.C. 102(e) as being anticipated by Bloomfield U.S. Patent No. 6023345.

5. Referencing claim 1, as closely interpreted by the Examiner, Bloomfield teaches a communication apparatus for communicating electronic mail data by connecting to the Internet, the apparatus comprising:

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6. determination means for determining a format of image data with reference to a database, in a case where communication of the electronic mail data with facsimile-format image data attached thereto is performed, (e.g., col. 18, line 57 – col. 19, line 45, “*...the Fax-Server 110 continues to store the fax data, in its native format (G3) as fax image data in a database on the Fax-Server 110...*”, “*The process 1020 continues at step 1070 where the Fax-Server 110 stores the E-mail address sent by the sender of fax interface device 106 in a database on Fax-Server 110. Then at step 1072 the Fax-Server 110 processes the stored fax images received from fax device 106 by converting the images to the formatted image data, being, as mentioned earlier, in a standard image data format for viewing on an E-mail terminal screen. Copies of the converted fax image (the formatted image data) are stored in respective databases on Fax-Server 110.*”);

and

7. communication means for performing communication pertaining to functional information, in addition to the communication of the electronic mail data after the format image data is determined by said determination means, (e.g., col. 18, line 57 – col. 19, line 45).

8. As per claim 2, as closely interpreted by the Examiner, Bloomfield teaches a communication apparatus comprising:

9. first connecting means for connecting to a local area network and a second connecting means for connecting to a wide area network, (e.g., Figs. 1, 7 and 13 & col. 4, line 37 – col. 5, line 5);

10. first communicating means for communicating electronic mail data by connecting to the Internet by one of said first and second connecting means, (e.g., Figs. 1, 7 and 13 & col. 4, line 37 – col. 5, line 5);

11. second communicating means for performing facsimile communication by connecting to the wide area network by said second connecting means, (e.g., Figs. 1, 7 and 13 & col. 4, line 37 – col. 5, line 5);

12. determination means for determining a format of image data with reference to a database, in a case where communication of the electronic mail data with facsimile-format image data attached thereto is performed, (e.g., col. 18, line 57 – col. 19, line 45); and

13. control means for controlling said first communication means so as to perform communication concerning functional information after the formal of the image data is determined by said determination means, (e.g., col. 18, line 57 – col. 19, line 45).

14. As per claim 4, as closely interpreted by the Examiner, Bloomfield teaches if there is no response to the communication concerning functional information from a communication partner apparatus with which said first communicating means communicates and if communication by said second communicating means is designated and a facsimile number of a receiving party is designated, said second communicating means communicates image data, (e.g., col. 16, lines 16 – 59 & col. 18, line 57 – col. 19, line 45).

15. As per claim 7, as closely interpreted by the Examiner, Bloomfield teaches if a communication error occurs during the communication by said first communicating means,

electronic mail data describing information concerning communication error information is transmitted to said communication partner apparatus or a previously designated electronic mail address, (e.g., col. 16, lines 16 – 59 & col. 18, line 57 – col. 19, line 45).

16. As per claim 8, as closely interpreted by the Examiner, Bloomfield teaches wherein if a communication error occurs during the communication by said first communicating means, electronic mail data having image data attached is transmitted to said communication partner apparatus or to a previously designated electronic mail address, (e.g., col. 16, lines 16 – 59 & col. 18, line 57 – col. 19, line 45).

17. As per claim 11, as closely interpreted by the Examiner, Bloomfield teaches wherein if connection to said first communicating means is dial-up connection, communication concerning functional information, communication of a text, and communication concerning delivery confirmation are successively performed by a single call, (e.g., col. 5, line 52 – col. 6, line 17 & col. 16, lines 16 – 59).

18. As per claim 12, as closely interpreted by the Examiner, Bloomfield teaches wherein if connection to said first communicating means is dial-up connection, communication concerning functional information, communication of a text, and communication concerning delivery confirmation are separately performed by at least two calls, (e.g., col. 5, line 52 – col. 6, line 17 & col. 16, lines 16 – 59).

19. As per claim 13, as closely interpreted by the Examiner, Bloomfield teaches wherein if connection to said first communicating means is dial-up connection, communication concerning functional information, communication of a text, and communication concerning delivery confirmation are successively performed by a single call or separately performed by different calls, (e.g., col. 5, line 52 – col. 6, line 17 & col. 16, lines 16 – 59).

20. As per claim 14, as closely interpreted by the Examiner, Bloomfield teaches wherein if connection to said first communicating means is dial-up connection, a line is once disconnected to wait for timeout processing in communication, (e.g., col. 5, line 52 – col. 6, line 17 & col. 16, lines 16 – 59).

21. As per claim 15, as closely interpreted by the Examiner, Bloomfield teaches wherein if connection to said first communicating means is dial-up connection, a line is once disconnected to wait for timeout processing in communication, and timeout is selectively verified by recall, (e.g., col. 5, line 52 – col. 6, line 17 & col. 16, lines 16 – 59).

22. As per claim 48, as closely interpreted by the Examiner, Bloomfield teaches wherein said wide area network is one of PSTN and ISDN, (e.g. col. 12, lines 1 – 33).

23. Claims 25, 27, 30, 31, 34 – 38, 42, 43, 45, 47, 49, 51 and 52 are rejected for similar reasons and can be found in the disclosed reference as stated above.

Claim Rejections - 35 USC § 103

24. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

25. Claims 3, 9, 10, 26, 32 and 33 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bloomfield in view of Applicant's admitted prior art.

26. As per claim 3, as closely interpreted by the Examiner, Bloomfield teaches all that is similar in nature above as it applies to the claim language below, furthermore Applicant's admitted prior art teaches if there is no response to the communication concerning functional information from a communication partner apparatus with which said first communicating means communicates, electronic mail data is sent by said first communicating means by attaching image data corresponding to a baseline image data format standard, (e.g. page 1, line 13 – page 3, line 20). Bloomfield teaches electronic mail data is sent by said first communicating means by attaching image data corresponding to a baseline image data format standard which the communication partner is able to process, (e.g., col. 6, line 47 – col. 7, line 7). It would have been obvious to one of ordinary skill in the art, at the time the invention was filed, to combine Applicant's admitted prior art with Bloomfield because utilizing a "baseline" image data format will allow for a common medium for most users to view and/or devices to process a standard format that is widely used.

27. As per claim 9, as closely interpreted by the Examiner, Bloomfield teaches wherein if a communication error occurs during the communication by said first communicating means, communication is performed in accordance with designation of whether transmission of electronic mail by attaching image data by a baseline image format standard which the communication partner is able to process or retransmission is to be performed, (e.g., col. 6, line 47 – col. 7, line 7); and image data corresponding to a baseline image data format standard which the communication partner is able to process, (e.g., col. 6, line 47 – col. 7, line 7). Furthermore, Applicant admits in prior art whether transmission of electronic mail by attaching image data by the most baseline image standards, (e.g. page 1, line 19 – page 3, line 20); It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Applicant's admitted prior art with Bloomfield for similar reasons stated above, furthermore, it would save time in transmission if a predefined “standard” communication means was established as a backup.

28. As per claim 10, as closely interpreted by the Examiner, Bloomfield teaches all that is similar in nature above as it applies to the claim language below, furthermore Applicant admits in the prior art that wherein the baseline image format standard is an MH coding system considered to be essential of functional information defined by ITU-T T.30, by which a resolution in a main scan direction is 8 pels/mm, a resolution in a sub-scan direction is 3.85 lines/mm, and an original width is 208 mm of A4 size, (e.g. page 1, line 19 – page 3, line 20). It

would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Applicant's admitted prior art with Bloomfield for similar reasons as stated above.

29. Claims 26, 32 and 33 are rejected for similar reasons as stated above.

30. Claims 5, 6, 22, 28, 29 and 41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bloomfield in view of Applicant's admitted prior art, in further view of Seo (6124947).

31. As per claim 5, as closely interpreted by the Examiner, Bloomfield does not specifically teach wherein if during the communication by said first communicating means a communication error occurs in communication of image data and in communication pertaining to delivery confirmation, retransmission is performed by selecting a number of times of retransmission from a plurality of individually preset number of times of retransmission including zero, in accordance with the contents of the communication error. Seo teaches wherein if during the communication by said first communicating means a communication error occurs in communication of image data and in communication pertaining to delivery confirmation, retransmission is performed by selecting a number of times of retransmission from a plurality of individually preset number of times of retransmission including zero, in accordance with the contents of the communication error, (e.g. col. 5, line 45 – col. 6, line 45). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Seo with the combine system of Bloomfield and Applicant's admitted prior art because it would be more convenient for a user to

input exactly how many time to attempt a retransmission if an error were to occur as opposed to having to go through the faxing process manually over and over again.

32. As per claim 6, as closely interpreted by the Examiner, Bloomfield, Applicant's admitted prior art and Seo do not specifically teach wherein no retransmission is performed if the contents of the communication error indicate that there is no destination address.

33. Examiner takes Official Notice (see MPEP § 2144.03) that " wherein no retransmission is performed if the contents of the communication error indicate that there is no destination address " in a computer networking environment was well known in the art at the time the invention was made. The Applicant is entitled to traverse any/all official notice taken in this action according to MPEP § 2144.03, namely, "if applicant traverses such an assertion, the examiner should cite a reference in support of his or her position". However, MPEP § 2144.03 further states "See also In re Boon, 439 F.2d 724, 169 USPQ 231 (CCPA 1971) (a challenge to the taking of judicial notice must contain adequate information or argument to create on its face a reasonable doubt regarding the circumstances justifying the judicial notice)." Specifically, In re Boon, 169 USPQ 231, 234 states "as we held in Ahlert, an applicant must be given the opportunity to challenge either the correctness of the fact asserted or the notoriety or repute of the reference cited in support of the assertion. We did not mean to imply by this statement that a bald challenge, with nothing more, would be all that was needed". Further note that 37 CFR § 1.671(c)(3) states "Judicial notice means official notice". Thus, a traversal by the Applicant that is merely "a bald challenge, with nothing more" will be given very little weight. It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine

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Applicant's admitted prior art with the combine system of Bloomfield, Applicant's admitted prior art and Seo because if there is no destination address there can be no retransmission let alone a first transmission without a destination address whether a email address or fax number.

34. Applicant has failed to seasonably challenge the Examiner's assertions of well known subject matter in the previous Office action(s) pursuant to the requirements set forth under MPEP §2144.03. A "seasonable challenge" is an explicit demand for evidence set forth by Applicant in the next response. Accordingly, the claim limitations the Examiner considered as "well known" in the first Office action, i.e. no retransmission is performed if the contents of the communication error indicate that there is no destination address, are now established as admitted prior art of record for the course of the prosecution. See *In re Chevenard*, 139 F.2d 71, 60 USPQ 239 (CCPA 1943).

35. As per claim 41, as closely interpreted by the Examiner, Bloomfield and Applicant's admitted prior art do not specifically teach switching a display on an operation panel related to functional information based on information in said database, if an address of another party is input in said first communication procedure. Seo teaches switching a display on an operation panel related to functional information based on information in said database, if an address of another party is input in said first communication procedure, (e.g., col. 5, lines 46 – 67). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Seo with the combine system of Bloomfield and Applicant's admitted prior art because of similar reasons stated above and furthermore it would be efficient for a system to display the

dynamism of information that is changing in the system so the user can confirm which numbers the information is being set to.

36. Claims 22, 28 and 29 are rejected for similar reasons and can be found in the disclosed reference as stated above.

37. Claims 16 – 20, 23, 24, 39 – 40, 46, 50, are rejected under 35 U.S.C. 103(a) as being unpatentable over Bloomfield in view of Applicant's admitted prior art, in further view of Miller, Jr. et al. (6356356) (hereinafter Miller).

38. As per claim 16, as closely interpreted by the Examiner, Bloomfield and Applicant's admitted prior art do not specifically teach wherein functional information of a destination apparatus is acquired by communication using one of said first and second communicating means, a database for holding a maximum capability supported by each function is registered or updated, and, if said first communicating means is to communicate data, the data is converted into a standard registered in said database and communicated. Miller teaches wherein functional information of a destination apparatus is acquired by communication using one of said first and second communicating means, a database for holding a maximum capability supported by each function is registered or updated, and, if said first communicating means is to communicate data, the data is converted into a standard registered in said database and communicated, (e.g. col. 3, line 30 – col. 4, line 55). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Miller with the combine system of Bloomfield and

Applicant's admitted prior art because it would be more efficient for a system to utilize the functionality of a database that is commonly used for storing information about users and/or devices on a network.

39. As per claim 17, as closely interpreted by the Examiner, Bloomfield teaches all that is described above but does not specifically teach wherein whether image data pertaining to said database is to be converted is set for each function item registered in said database. Miller teaches wherein whether image data pertaining to said database is to be converted is set for each function item registered in said database, (e.g. col. 3, line 30 – col. 4, line 55). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Miller with the combine system of Bloomfield and Applicant's admitted prior art because it would be cause less errors in the receiving system if the data was converted to a format that the receiving system could process.

40. As per claim 18, as closely interpreted by the Examiner, Bloomfield and Applicant's admitted prior art do not specifically teach if an address of another party with respect to said first communicating means is input, display information related to functional information is switched on an operation based on information in said database.

41. Miller teaches if an address of another party with respect to said first communicating means is input, display information related to functional information is switched on an operation based on information in said database, (e.g. col. 3, line 30 – col. 4, line 55). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Miller

with the combine system of Bloomfield and Applicant's admitted prior art because it would be more convenient for a user to have the system convert the destination number to the address that it is associated with it.

42. As per claim 19, as closely interpreted by the Examiner, Bloomfield teaches wherein if a communication error occurs in said first communicating means, said second communicating means communicates image data if communication by said second communicating means is designated and a telephone number of another party is set. Miller teaches wherein if a communication error occurs in said first communicating means, said second communicating means communicates image data if communication by said second communicating means is designated and a telephone number of another party is set, (e.g. col. 3, line 30 – col. 4, line 55). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Miller with the combine system of Bloomfield and Applicant's admitted prior art for similar reasons as stated above.

43. Claims 20, 23, 24, 39 – 40, 46, 50, are rejected for similar reasons and can be found in the disclosed reference as stated above.

44. Claims 21 and 44 rejected under 35 U.S.C. 103(a) as being unpatentable over Bloomfield in view of Applicant's admitted prior art, in further view of Wolf (6535303).

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45. As per claim 21, as closely interpreted by the Examiner, Bloomfield and Applicant's admitted prior art teaches all that is described above but does not specifically teach wherein when said first communicating means is to perform communication concerning the functional information, of pieces of functional information defined by ITU-T T.30, functional information pertaining to communication such as a handshake rate, a modem rate, a minimum transmission time, the presence/absence of error correction mode, and the presence/absence of G4 function need not be exchanged. Applicant's admitted prior art teaches wherein when said first communicating means is to perform communication concerning the functional information, of pieces of functional information defined by ITU-T T.30, functional information pertaining to communication such as a handshake rate, a modem rate, a minimum transmission time, the presence/absence of error correction mode need not be exchanged, (e.g. page 1, line 13 – page 3, line 20) and Wolf teaches the G4 function, (e.g. col. 3, lines 14 – 61). It would have been obvious to one of ordinary skill in the art at the time the invention was made to combine Wolf with the combine system of Bloomfield and Applicant's admitted prior art for similar reasons as stated above.

46. Claim 44 is rejected for similar reasons and can be found in the disclosed reference as stated above.

Response to Arguments

47. Applicant's arguments with respect to claims 1 – 52 have been considered but are moot in view of the new ground(s) of rejection.

48. Applicant is invited to contact the Examiner for an interview on the claim languages and interpretation to aid in furthering prosecution.

Conclusion

49. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

50. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

51. a. Stewart et al. U.S. Patent No. 6389460 discloses Method and apparatus for efficient storage and retrieval of objects in and from an object storage device.

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52. b. Wang et al. U.S. Patent No. 5802361 discloses Method and system for searching graphic images and videos.

53. c. Freeman U.S. Patent No. 6020980 discloses Facsimile delivery to electronic mail.

54. d. Brunson U.S. Patent No. 5647002 discloses Synchronization of mailboxes of different types.

55. e. Baran U.S. Patent No. 5247591 discloses Method and apparatus for the primary and secondary routing of fax messages using hand printed characters.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David E. England whose telephone number is 571-272-3912.

The examiner can normally be reached on Mon-Thur, 7:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David A. Wiley can be reached on 571-272-3923. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

David E. England
Examiner
Art Unit 2143

De *DE*


DAVID WILEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100